6/AF/2645 4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Cook et al.** §

§

Serial No.: **09/300,320** §

§

Filed: **April 27, 1999** §

§

For: **Method and Apparatus for** §
Sending Messages in a Data Processing §
System §

§

Group Art Unit: **2645**

Examiner: **Hoosain, Allan**

Attorney Docket No.: **AT9-99-159**

35525
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Sir:
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• Appellant's Brief (in triplicate) (37 C.F.R. 1.192); and
• Our return postcard.

A fee of $330.00 is required for filing an Appellant's Brief. Please charge this fee to IBM Corporation Deposit Account No. 09-0447. No additional fees are believed to be necessary. If, however, any additional fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0447. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0447.

Respectfully submitted,
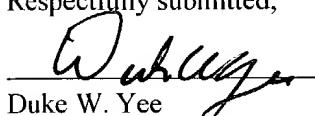
Duke W. Yee
Registration No. 34,285
YEE & ASSOCIATES, P.C.
P.O. Box 802333
Dallas, Texas 75380
(972) 367-2001
ATTORNEY FOR APPLICANTS

PATENT

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ATTENTION: Board of Patent Appeals
and Interferences

APPELLANT'S BRIEF (37 C.F.R. 1.192)

This brief is in furtherance of the Notice of Appeal, filed in this case on May 17, 2004.

The fees required under § 1.17(c), and any required petition for extension of time for filing this brief and fees therefore, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief is transmitted in triplicate. (37 C.F.R. 1.192(a))

REAL PARTIES IN INTEREST

The real party in interest in this appeal is the following party: International Business Machines Corporation

RELATED APPEALS AND INTERFERENCES

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no such appeals or interferences.

STATUS OF CLAIMS

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 1-7, 10-22, and 25-33

B. STATUS OF ALL THE CLAIMS IN APPLICATION

1. Claims canceled: 8, 9, 23, 24
2. Claims withdrawn from consideration but not canceled: NONE
3. Claims pending: 1-7, 10-22, and 25-33
4. Claims allowed: NONE
5. Claims rejected: 1-7, 10-22, and 25-33

C. CLAIMS ON APPEAL

The claims on appeal are: 1-7, 10-22, and 25-33

STATUS OF AMENDMENTS

An amendment canceling claims 10-13, 25-28, and 31 is filed herewith. The amendment merely cancels claims without adding any claims. Thus, the amendment simplifies issues for appeal and does not require further search and consideration. Accordingly, Appellants respectfully request the amendment be entered for the purposes of this appeal.

SUMMARY OF INVENTION

The present invention provides a method and apparatus in a computer for processing voice messages. A graphical user interface is provided for recording a voice message. See specification, page 17, lines 2-26; Figure 6. Responsive to recording of the voice message in the graphical user interface, an identifying string is automatically inserted into a text message identifying a presence of a voice message and the voice message is automatically appended to a text message to form an appended voice message. See specification, page 20, lines 12-23. The text message is sent with the appended voice message. When a message is received, the text in the received message is parsed to see if an identifying string is present indicating that the received message is a voice message. Responsive to a determination that the received message includes customized content of a particular type, a graphical user interface including controls for presenting the customized message is displayed. See specification, at least page 23, lines 16-25.

ISSUES

The issues on appeal are as follows:

Whether claims 1-7, 14-22, and 29-33 are anticipated under 35 U.S.C. § 102(e) by Sonnenfeld (U.S. Patent No. 6,112,049).

GROUPING OF CLAIMS

The claims on appeal do not stand or fall in a single group, but are grouped into in the following groups for the reasons set forth in the Argument section below:

Claims 1-7, 14-22, 29, and 30 form group A. Claims 32 and 33 form group B.

ARGUMENT

I.   The Prior Art Fails to Teach or Suggest Automatically Inserting an Indicator into a Text Message (Groups A and B)

The Office Action rejects claims 1-7, 14-22, 29-30, 32, and 33 under 35 U.S.C. § 102 as being anticipated by *Sonnenfeld* (U.S. Patent No. 6,112,049). This rejection is respectfully traversed.

With respect to claims 1, 3, 16, and 18, the Office Action states:

As to Claims 1, 3, 16, 18, with respect to Figure 1, **Sonnenfeld** teaches a method in a data processing system for processing explanation voice clips (voice messages), the method comprising the data processing system implemented steps of:

      responsive to a request from a test designer (user) to record an explanation voice clip (voice message), presenting a graphical user interface for composing a test (text message), wherein the graphical user interface includes a test taker (recipient field) for entering a recipient address and controls for recording an explanation voice clip (voice message) (Col. 56, lines 25-32);

      responsive to a request to send the text message, automatically inserting an explanation HTML tag (indicator) into the text message indicating a presence of a voice clip (voice message) (Col. 16, lines 60-66, Col. 42, line 66 through Col. 43, line 16);

      responsive to the request to send the text message, automatically appending the voice message to the text message to form an appended voice message (Col. 56, lines 25-54); and

      sending the text message with the appended voice message to the recipient address (Col. 56, lines 33-54).

Office Action, dated March 18, 2004. Appellants respectfully disagree. *Sonnenfeld* teaches a system for computer based training. A host may transmit information defining at least one query section to a client system. The responses are then transmitted to the query server, which processes this information and produces an output. See *Sonnenfeld*, Abstract.

In contradistinction, claim 1 recites:

1.   A method in a data processing system for processing voice messages, the method comprising the data processing system implemented steps of:

      responsive to a request from a user to record a voice message, presenting **a graphical user interface** for composing a text message, wherein the graphical user interface includes **a recipient field** for entering a recipient address and **controls for recording a voice message**;

      responsive to the user entering a recipient address in the recipient field and **recording a voice message using the controls**, forming a text message to be sent to the recipient address;

      responsive to a request to send the text message, automatically **inserting an indicator into the text message indicating a presence of a voice message**;

      responsive to the request to send the text message, **automatically appending the voice message to the text message** to form an appended voice message; and

      sending the text message with the appended voice message to the recipient address. [emphasis added]

Thus, claim 1 recites a graphical user interface that is used to record a voice message, responsive

to which an indicator is inserted into a text message and the voice message is appended to the text message. *Sonnenfeld* fails to teach or suggest **automatically inserting** an indicator into a text message indicating a presence of a voice message and **automatically appending** the voice message to the text message, responsive to recording of the voice message using the controls of a graphical user interface, as recited in claims 1 and 16.

Sonnenfeld teaches an email screen that allows a test designer to send an email to a test taker. As such, the email screen includes a recipient field. The cited portion of *Sonnenfeld* states:

> Test Taker Email Screen
> This web page appears after the test designer clicks the Email button on both the "Your Personal Test Takers" Screen and "Test Taker View" Screen. This page allows the test designer to send email to the test taker. No password is required. This screen includes the following elements. Refer to the "Create A New Test Taker" Screen for a list of fields and their meaning.
> Enter The Information In The Form Below And Then Send The Email To The Test Taker By Pressing `Send` .cndot. This message indicates what to do in order to send email to the test taker. Following this message, the test taker account information is displayed for the reference:
> > Logon ID
> > Name
> > Phone Number
> > E-Mail Address
> > Address, Line #1
> > Address, Line #2
> > City
> > State
> > Zipcode
> > Fax Number
> > Message For Test Taker .cndot. This field indicates the
> email message the test designer wishes to send to the test taker. It can be anything the test designer desires and is required (why else send a message if the test designer doesn't have a message to send?).

Sonnenfeld, col. 56, lines 25-54. Nowhere does this section or any other section of the reference teach or suggest that the email screen includes controls for recording a voice message.

Another cited portion of *Sonnenfeld* states:

> Not only can the preface and summary have individualized

> instructions on them, but the test designer can also control how
> much time is spent looking at (reading) them, the number of times
> they can read the instructions and ask questions in order to get
> feedback from the test taker. These sections may also include a
> video clip or play a sound clip telling the test taker how to
> complete the test.

Sonnenfeld, col. 16, lines 60-66. Thus, *Sonnenfeld* does teach that a sound clip may be played during a test. However, *Sonnenfeld* does not teach or suggest that this sound clip has anything to do with the test taker email screen. Still another cited portion states:

> Explanation (HTML Tags OK) (Reason For Answer)• This
> field represents an explanation to the logic of the question. It gives
> the test designer the opportunity to explain or show why an answer
> to the question is correct or incorrect. It also gives the test designer
> the opportunity to discuss anything about the question that is
> relevant. The explanation will appear when the answers to the
> questions on a test are displayed (if allowed at all). It appears as a
> hyper-text link next to the question when showing the answers. By
> clicking on this link, the explanation is displayed in the browser.
> Embedding HTML tags in explanations is allowed. This gives the
> test designer the opportunity to create new, dynamic, and
> interesting types of explanations. Explanations can be tailored and
> are unlimited in concept (they are only limited by the web and the
> test designer's imagination). For example, explanations can contain
> movies, pictures or voice clips indicating the logic of the question.
> An instructor can be displayed lecturing about why the answer to
> the question is justified. Hyper-text links can be embedded in the
> explanation which take the test designer to other places on the web
> to learn more about the material. This can be used as a way to learn
> more about the material of the question and can serve to reinforce
> the theoretical principles behind the question. It should be
> remembered that tests exist as a way to learn and better yourself as
> well as the means to learn about the skills of someone. Using
> HTML tags in questions and explanations gives a new way for the
> test designer to teach. Be imaginative and create interesting and
> informative tests. The Explanation field is not case-sensitive and
> not required.

Sonnenfeld, col. 42, line 66, to col. 43, line 27. Thus, *Sonnenfeld* teaches that HTML tags can be used in a question in a test. The HTML tag appears as a hypertext link, which directs the test taker to another resource on the Internet. The resource may be, for example, a video file or a voice clip. However, *Sonnenfeld* does not teach or suggest that this has anything to do with the

test taker email screen. The Office Action fails to address the fact that the actual test and separate email messages sent from the test designer to test takers are completely separate features of *Sonnenfeld*. The Office Action references the disparate sections of the references as if they are disclosing a single, integrated feature.

Furthermore, the HTML tags of *Sonnenfeld* point to separate resources on the Internet. *Sonnenfeld* does not teach or fairly suggest automatically appending a sound clip to a text message. In fact, *Sonnenfeld* teaches away from this feature, because *Sonnenfeld* teaches inserting an HTML tag to a remote resource rather than appending the resource to the text message.

Moreover, the Office Action does not explain how the feature of inserting HTML tags into a test is being combined with the separate feature of an email screen. *Sonnenfeld* is being applied under 35 U.S.C. § 102. Because modification must be made in order to arrive at the present invention, rejection under 35 U.S.C. §102 is improper. Simply stated, *Sonnenfeld* does not anticipate the invention recited in at least claims 1 and 16, for example. Appellants submit that a person of ordinary skill in the art would not be motivated to combine disparate features from the *Sonnenfeld* teachings. The only motivation for modifying *Sonnenfeld* in this manner would be to reconstruct the presently claimed invention

The applied reference fails to teach or suggest each and every claim limitation; therefore, *Sonnenfeld* does not anticipate claims 1 and 16. Independent claim 29 recites similar features and is allowable for the same reasons. *Sonnenfeld* does not anticipate claims 1, 16, and 29 and Appellants respectfully submit that the rejection should be overturned.

Since claims 2-7, 17-22, 30, 32, and 33 depend from claims 1, 16, and 29, the same distinctions between *Sonnenfeld* and the invention recited in claims 1, 16, and 29 apply for these claims. Additionally, claims 2-7, 17-22, 30, 32, and 33 recite other additional combinations of features not suggested by the reference. Consequently, Appellants respectfully urge that the rejection of claims 1-7, 16-22, 29, 30, 32, and 33 be overturned.

With respect to claims 14 and 29, the Office Action states:

> As to Claims 14,29, with respect to Figure 1, **Sonnenfeld** teaches a messaging system for use in a data processing system, the messaging system comprising:
> a graphical user interface, wherein the graphical user interface provides selections for test designer (user) input to create and send sound clips (voice messages) (Col. 16, lines 64-67); and

an Interactive Testing System (ITS) (message processing mechanism),
wherein the message processing mechanism has a plurality of modes of operation
including (Col. 15, lines 50-54):

a first mode of operation in which the message processing
mechanism waits for a user input (Col. 17, lines 1-8);

a second mode of operation, responsive to a user input in the first
mode of operation to record a sound clip (voice message), in which the message
processing mechanism presenting a graphical user interface for composing a
summary (text message), wherein the graphical user interface includes a test taker
(recipient field) for entering a recipient address and controls for recording a sound
clip (voice message) (Col. 14, lines 31-35 and Col. 19, lines 33-48);

a third mode of operation, responsive to a user input in the first
mode of operation to enter a recipient address for the voice message, in which the
message processing mechanism receives entry of a recipient address for the voice
message (Col. 19, lines 33-48); and

a fourth mode of operation, responsive to a user recording the
voice message using the controls, in which the message processing mechanism
stores the voice message in a sound clip (file) (Col. 16, lines 64-66); and

a fifth mode of operation, responsive to a user input in the first
mode of operation to send the voice message and to a presence of a recipient
address for the voice message, in which the message processing mechanism
creates a text message, inserts an identifying string that identifies a presence of the
voice message in the text message, appends the file to the text message, and sends
the text message to the recipient address (Col. 16, lines 60-66 and Col. 43, lines 8-
17).

Office Action, dated March 18, 2004. Appellants respectfully disagree. Claims 14 and 29 recite

features similar to those presented in claims 1-7, 16-22, 29, 30, 32, and 33 and are allowable for

the same reasons. Again, the Office Action alleges that *Sonnenfeld* teaches the combination of

features in claims 14 and 29 because *Sonnenfeld* teaches that HTML tags can be used in a

question in a test. As stated above, the HTML tag appears as a hypertext link, which directs the

test taker to another resource on the Internet. *Sonnenfeld* actually teaches away from the features

recited in claims 14 and 29, because *Sonnenfeld* teaches inserting an HTML tag to a remote

resource rather than appending the resource to the text message.

The applied reference fails to teach or suggest each and every claim limitation; therefore,

Sonnenfeld does not anticipate claims 14 and 29. Since claims 15 and 30 depend from claims 1

and 29, the same distinctions between *Sonnenfeld* and the invention recited in claims 1, 16, and

29 apply for these claims. Additionally, claims 15 and 30 recite other additional combinations of

features not suggested by the reference. Consequently, Appellants respectfully urge that the

rejection of claims 14, 15, 29, and 30 be overturned.

II.   The Prior Art Fails to Teach or Suggest Inserting the Indicator into a Body of the Text Message (Group B)

Particularly, claims 32 and 33 recite inserting the indicator into a body of the text message. *Sonnenfeld* does not teach or suggest inserting an indicator into a text message indicating a presence of a voice message, responsive to a request to send the text message, which is formed responsive to the user entering a recipient address in the recipient field and recording a voice message using the controls. Therefore, it follows that *Sonnenfeld* also fails to teach inserting a text string **within the body** of the text message, as recited in claims 32 and 33. At best, *Sonnenfeld* teaches storing an HTML tag that points to a remote file; however, the HTML tag is not automatically inserted responsive to the user entering a recipient address. Furthermore, the test question section of *Sonnenfeld* in which the HTML tag is inserted is not a body of a text message for which a user enters a recipient address. The reference fails to teach each and every claim limitation. Therefore, *Sonnenfeld* does not anticipate claims 32 and 33.

V.   Conclusion

In view of the above, Appellants respectfully submit that the rejections of claims 1-7, 14-22, and 29-33 are overcome. Accordingly, it is respectfully urged that the rejections of claims 1-7, 14-22, and 29-33 not be sustained.
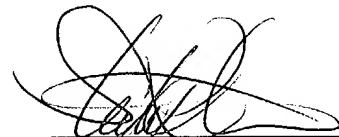
Stephen R. Tkacs
Reg. No. 46,430
YEE & ASSOCIATES, P.C.
PO Box 802333
Dallas, TX 75380
(972) 367-2001

APPENDIX OF CLAIMS

The text of the claims involved in the appeal reads:

1.   A method in a data processing system for processing voice messages, the method comprising the data processing system implemented steps of:

responsive to a request from a user to record a voice message, presenting a graphical user interface for composing a text message, wherein the graphical user interface includes a recipient field for entering a recipient address and controls for recording a voice message;

responsive to the user entering a recipient address in the recipient field and recording a voice message using the controls, forming a text message to be sent to the recipient address;

responsive to a request to send the text message, automatically inserting an indicator into the text message indicating a presence of a voice message;

responsive to the request to send the text message, automatically appending the voice message to the text message to form an appended voice message; and

sending the text message with the appended voice message to the recipient address.

2.   The method of claim 1 further comprising:

receiving the text message to form a received text message;

parsing the received text message for a presence of an indicator indicating that the received text message is a voice message; and

responsive to a presence of the indicator, presenting controls to listen to the voice message.

3.   The method of claim 1, wherein the text message is an electronic mail message.

4.   The method of claim 1, wherein the indicator is a text string.

5.   The method of claim 1, wherein the data processing system is a personal computer.

6.   The method of claim 1, wherein the data processing system is a work station.

7.   The method of claim 1, wherein the data processing system is a personal digital

assistant.

14.   A messaging system for use in a data processing system, the messaging system

comprising:

        a graphical user interface, wherein the graphical user interface provides selections for user

input to create and send voice messages; and

        a message processing mechanism, wherein the message processing mechanism has a

plurality of modes of operation including:

                a first mode of operation in which the message processing mechanism waits for a

user input;

                a second mode of operation, responsive to a user input in the first mode of

operation to record a voice message, in which the message processing mechanism

presenting a graphical user interface for composing a text message, wherein the graphical

user interface includes a recipient field for entering a recipient address and controls for recording a voice message;

a third mode of operation, responsive to a user input in the first mode of operation to enter a recipient address for the voice message, in which the message processing mechanism receives entry of a recipient address for the voice message;

a fourth mode of operation, responsive to a user recording the voice message using the controls, in which the message processing mechanism stores the voice message in a file; and

a fifth mode of operation, responsive to a user input in the first mode of operation to send the voice message and to a presence of a recipient address for the voice message, in which the message processing mechanism creates a text message, inserts an identifying string that identifies a presence of the voice message in the text message, appends the file to the text message, and sends the text message to the recipient address.

15. The messaging system of claim 14, wherein the message processing mechanism further includes:

a sixth mode of operation in which the message processing mechanism waits for a receipt of a text message;

a seventh mode of operation, responsive to receiving a text message, in which the message processing mechanism parses the text message to determine whether an identifying string identifying a presence of a voice message is present; and

an eighth mode of operation, responsive to a presence of the identifying string, in which the message processing mechanism causes the graphical user interface to display the message as

a voice message in a message list.

16.   A data processing system for processing voice messages, the data processing system comprising:

presentation means, responsive to a request from a user to record a voice message, for presenting a graphical user interface for composing a text message, wherein the graphical user interface includes a recipient field for entering a recipient address and controls for recording a voice message;

forming means, responsive to the user entering a recipient address in the recipient field and recording a voice message using the controls, for forming a text message to be sent to the recipient address;

inserting means, responsive to a request from the user to send the text message, for automatically inserting an indicator into the text message indicating a presence of a voice message;

appending means, responsive to the request to send the text message, for automatically appending the voice message to the text message to form an appended voice message; and

sending means for sending the text message with the appended voice message to the recipient address.

17.   The data processing system of claim 16 further comprising:

receiving means for receiving the text message to form a received text message;

parsing means for parsing the received text message for a presence of an indicator indicating that the received text message is a voice message; and

presenting means, responsive to a presence of the indicator, for presenting controls to listen to the voice message.

18.   The data processing system of claim 16, wherein the text message is an electronic mail message.

19.   The data processing system of claim 16, wherein the indicator is a text string.

20.   The data processing system of claim 16, wherein the data processing system is a personal computer.

21.   The data processing system of claim 16, wherein the data processing system is a work station.

22.   The data processing system of claim 16, wherein the data processing system is a personal digital assistant.

29.   A computer program product in a computer readable medium for processing voice messages, the computer program product comprising:

first instructions, responsive to a request from a user to record a voice message, for presenting a graphical user interface for composing a text message, wherein the graphical user interface includes a recipient field for entering a recipient address and controls for recording a voice message;

second instructions, responsive to the user entering a recipient address in the recipient

field and recording a voice message using the controls, for forming a text message to be sent to the recipient address;

third instructions, responsive to a request from the user to send the text message, for automatically inserting an indicator into the text message indicating a presence of a voice message;

fourth instructions, responsive to the request to send the text message, for automatically appending the voice message to the text message to form an appended voice message; and

fifth instructions for sending the text message with the appended voice message to the recipient address.

30.   The computer program product of claim 29 further comprising:

sixth instructions for receiving the text message to form a received text message;

seventh instructions for parsing the received text message for a presence of an indicator indicating that the received text message is a voice message; and

eighth instructions, responsive to a presence of the indicator, for presenting controls to listen to the voice message.

32.   The method of claim 1, wherein the step of automatically inserting an indicator into a text message comprises inserting the indicator into a body of the text message.

33.   The data processing system of claim 16, wherein the inserting means comprises means for inserting the indicator into a body of the text message.